

REMARKS

The Applicant and Applicant's attorney wish to thank the Examiner for the time spent reviewing the application and preparing the Office Action. In the Office Action, claims 1, 3-12, 15-21, 23-25, 27-31, 33-37 and 39-42 were rejected. By this paper, independent claims 1, 12, 23 and 24 have been amended. Applicant submits that claim amendments do not add new matter and entry thereof is respectfully requested. As a result, claims 1, 3-12, 15-21, 23-25, 27-31, 33-37 and 39-42 are pending and should be in condition for allowance. Reconsideration of the above-identified claims is now respectfully requested.

Rejections Under 35 U.S.C. § 103

In the Office Action, claims 1, 3-12, 15-21, 23-25, 27-31, 33-37 and 39-42 were rejected under 35 U.S.C. § 103 as being obvious in light of U.S. Patent No. 5,517,405 to McAndrew et al. ("McAndrew") in view of U.S. Patent No. 6,283,761 to Joao ("Joao") and further in view of "Lifechart.com Takes Next Step to monitoring Health Online: First E-Health company of Its Kind to Expand Services With Wireless Applications" by PR Newswire (New York: Apr 12, 2000. pg. 1) (hereinafter "PR Newswire").

The PR Newswire reference is directed toward a system that provides patients an interactive, low-cost means to communicate with healthcare professionals via the Internet, wireless technology, fax or mail. *See* ¶4, pg. 2. More specifically, the system is used to access and monitor health online, via a Wireless Application Protocol ("WAP") – ready phone. *See* ¶1, pg. 2. The system employs devices, such as WAP – ready phones to receive and store user data on the web, allowing online consultations with healthcare professionals. *See* ¶4, pg. 2. For example, a patient may measure their lung function on a handheld monitor and then upload the

clinical data through a telephone line onto the Internet. *See* ¶5, pg. 2. With web access from any location, authorized healthcare professionals can monitor the patient's clinical progress, prescribe or modify medication and schedule office visits. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness. In particular, the McAndrew, Joao and PR Newswire references fail to teach or suggest all the claim limitations as recited in the claims. Furthermore, the McAndrew, Joao and PR Newswire references fail to provide some suggestion or motivation to modify the references or combine reference teachings.

It was conceded in the Office Action that McAndrew and Joao do not disclose the claim limitations of “upon identifying at least one patient which a clinician will treat during a time period and for which the clinician is to receive decision-supported patient data to assist the clinician in the medical care the at least one patient”, “being”, “the”, “which the clinician will treat in the time period”, “to”, “the [configuration] of the data being selected from a default configuration associated with the mobile user module or a customized configuration selected by the clinician”. *See* Office Action, pg. 3.

The PR Newswire reference was used in the Office Action to remedy the above-mentioned lack of disclosure or teaching. However, the PR Newswire reference fails to teach or suggest the limitations that were not present in the McAndrew or Joao references. With regards to claims 1 and 12, the PR Newswire reference fails to teach or suggest accessing patient data upon identifying at least one patient which the clinician is to receive decision-supported patient data to assist the clinician in the medical care of the at least one patient, as recited in claims 1 and 12. Rather, the PR Newswire is directed to a system that provides patients a means to communicate with a healthcare professional. In the PR Newswire, the patient can upload information about themselves which can thereafter be accessed by a physician. This information is generated by the patient, it is not decision-supported patient data, as respectively defined in claims 1 and 12. Likewise, the PR Newswire reference fails to teach or suggest a clinician being presented with generated decision-supported patient data, as respectively defined in each of claims 1 and 12, for the at least one patient which the clinician will treat in the time period, as respectively defined in claims 1 and 12, in a configuration to assist the clinician in treating the at least one patient, as recited in claims 1 and 12.

Furthermore, the PR Newswire reference fails to teach or suggest a method or system where the configuration of the generated decision-supported patient data, as respectively defined in each of claims 1, 12, 23 and 24, is selected from a default configuration associated with the mobile user module or a customized configuration selected by the clinician, as required by each of claims 1, 12, 23 and 24. Also, the PR Newswire reference fails to teach or suggest the clinician being presented with decision-supported patient data, as defined and recited in claim 24.

In the Office Action, it is alleged that it would have been obvious to combine the teachings of PR Newswire with McAndrew and Joao with the motivation of “providing ‘fast – changing world of Internet technology, which becomes more important that patients and physicians continue to connect in way that will improve communications, treatment and health outcomes (See PR Newswire, Page 1, Paragraph 3).” However, this statement appears to be out of context, as the PR Newswire reads “[i]n the fast-changing world of Internet technology, it becomes more important that patients and physicians continue to connect in ways that will improve communications, treatments and health outcomes.” See ¶2, pg. 2. The PR Newswire teaches of a service that provides patients with a low-cost means to communicate with healthcare professionals via the Internet, wireless technology, fax or mail (again, see the asthma example, ¶5, pg. 2, or the diabetes example, ¶6, pg. 2), not a method for delivering decision-supported patient data, as defined in the claims, from a decision-support module to a mobile user module. The data utilized by physician, as discussed in the PR Newswire reference, is data provided from the patient which can be viewed by a physician. On the other hand, the data utilized by the clinician, as claimed in the pending claims, is decision-supported patient data generated by evaluating patient data using updatable rules and parameters from a expert knowledge module.

Accordingly, Applicant submits that pending claims 1, 3-12, 15-21, 23-25, 27-31, 33-37 and 39-42, as amended and presented herein, are neither disclosed or obviated by the McAndrew, Joao or the PR Newswire references. As such, it is requested that the rejection under 35 U.S.C. §103 to the above-identified claims be removed. Reconsideration and allowance of the above-identified claims is now respectfully requested.

Conclusion

By this paper pending claims 1, 12, 23 and 24 have been amended for the sake of clarity or to more clearly point out the novel aspects of Applicant's invention. As a result, claims 1, 3-12, 15-21, 23-25, 27-31, 33-37 and 39-42 are pending and should be in condition for allowance. Reconsideration and allowance of the above-identified claims is now respectfully requested.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 4 day of May 2006.

Respectfully submitted,



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